



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

CJ

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,452	06/10/2001	Kazuo Sugamura	2001-0572A	4276
513	7590	02/23/2006	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			LEE, BETTY L	
		ART UNIT	PAPER NUMBER	1647

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/831,452	SUGAMURA ET AL.
	Examiner	Art Unit
	Betty Lee, Ph.D.	1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 December 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 5 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 and 5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Applicant's response filed December 7, 2005 is acknowledged. Claims 4, 6-14 are cancelled. Claims 1-3 and 5 are pending and under examination. The text of those sections of Title 35 U.S. Code, not included in this action can be found in a prior office action.

Claim Rejections Withdrawn ***Claim Rejections - 35 USC § 112***

The rejection of claims 1-3 and 5 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn pursuant to Applicant's arguments of 12/7/2005, which were persuasive.

Claim Rejections Maintained ***Claim Rejections - 35 USC § 102***

The rejection of claims 2 and 3 under 35 U.S.C. 102(b) as anticipated by Yu, et al. is maintained for the reasons of record in the rejection of 6/7/05. Applicant's arguments have been fully considered but they are not persuasive.

Applicant asserts that Yu, et al. do not disclose or suggest an hAMSH protein, or one having the amino acid sequence of SEQ ID NO. 1 or the function of the protein as a signal transduction molecule for cell proliferation but disclose the cDNA clone that contains the 1st-1356th nucleotide sequence of SEQ ID NO: 2 of the instant application. Applicant further asserts that Yu, et al. do not disclose the coding region (11th to the 1285th nucleotide of SEQ ID NO: 2) for a protein.

In response to Applicant's assertions, the discovery of a new property of a previously known compound does not make the product patentable. The function disclosed in the present claims is inherent to the protein of the prior art. Applicant asserts that Yu fails to disclose a hAMSH protein, let alone the amino acid sequence of SEQ ID NO. 1. In response to Applicant's assertion, Yu's disclosure of the nucleic acid sequence encompasses the hAMSH protein of SEQ ID NO. 1. Yu's cDNA clone encompasses the nucleotide sequence of SEQ ID NO. 2 of the instant application. Applicant also asserts that Yu do not disclose the coding region for a protein. In response to Applicant's assertion, the coding region of the protein is encompassed by the nucleotide sequence even though Yu does not mention it.

The preceding rejection is based on the judicial precedent following *In re Fitzgerald*, 205 USPQ 594 because the prior art is silent with regard to the properties or function of the protein.

Claim Rejections - 35 USC § 103

The rejection of claim 5 under 35 U.S.C. 103(a) as obvious over Yu, et al. is maintained for the reasons of record in the rejection of 6/7/05. Applicant's arguments have been fully considered but they are not persuasive.

Applicant traverses the rejection for the same reasons as set forth *supra*. In response to Applicant's assertions, the inherent property of a molecule is present even if the prior art is silent.

Conclusion

No claims are allowed.

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betty Lee, Ph.D. whose telephone number is (571) 272-8152. The examiner can normally be reached on M-F 9 am-5: 30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BLL

Brenda Brumback
BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600